

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
CENTRAL FAX CENTER

In re Application of: FREITAG et al.)
Serial No.: 10/598,505) Group Art Unit: TBA
Filed: March 4, 2005) Examiner: TBA
) Conf. No.: 6583

AUG 06 2008

For: Recording Medium Storage Package Having Improved Rosette

Mail Stop PCT
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 C.F.R § 1.47(a)

Dear Sir:

This is a Petition under Rule 1.47(a) to allow two inventors to make the application for patent referenced above, where the third inventor (James Philippe) refuses to join.

Pursuant to Rule 1.47(a), this Petition includes proof of the pertinent facts shown in the Statement of Facts enclosed herewith referencing the enclosed exhibits entitled "Exhibits in Support of Statement of Facts." Further, Pursuant to Rule 1.47(a), this Petition includes provision for the payment of the fee in Rule 1.17(g). In compliance with Rule 1.47(a), this Petition states the last known address of the non-signing inventor, Mr. James Philippe. The Statement of Facts enclosed herewith also states the last known address of the non-signing inventor. Also submitted with this Petition is the Declaration of the two signing inventors on behalf of themselves and the non-signing inventor pursuant to Rule 1.47(a).

08/08/2008 LLANDERA 00000036 041105 10598505

02 FC:1453 200.00 DA

STM 254610.1

Serial No. 10/598,505
Attorney Docket No. CPG 03-56 PM US (52888-82170)

PATENT

LAST KNOWN ADDRESS OF THE NONSIGNING INVENTOR

Pursuant to Rule 1.47(a), the last known address of Mr. Philippe, is

James Philippe
7 Deborah Ave.
Sanford, ME 04073

RELIEF REQUESTED

Applicants respectfully request the Commissioner accept the Declarations submitted herewith, executed by the two remaining inventors on behalf of themselves and on behalf of Mr. Philippe pursuant to Rule 1.47(a). Applicants further respectfully request that the examination of the subject application commence promptly.

REQUIRED FEE

The Commissioner is hereby authorized to charge all fees due in association with this petition and late filing of the oath and declaration, including the \$200 fee set forth in 37 CFR 1.17(g) and the \$130 fee set forth in 37 CFR 1.16(f), to Deposit Account No. 04-1105, under Order No. 82170(52888). However, if for any reason the fee is inadequate for the consideration of this Petition, or credit is owed for any excess fee paid, you are hereby authorized and requested to charge Deposit Account No. 04-1105.

Serial No. 10/598,505
Attorney Docket No. CPG 03-56 PM US (52888-82170)

PATENT

Respectfully submitted,


Michael J. Pollack Reg. No. 53,475
Agent for Applicants

Date: August 6, 2008

Intellectual Property Practice Group
EDWARDS ANGELL PALMER & DODGE, LLP
P.O. Box 55874
Boston, MA 02205
Tel: (203) 353-6848
Fax: (203) 975-7180

Please direct correspondence to:

MeadWestvaco Corporation
299 Park Avenue
New York, NY 10171
UNITED STATES

Customer No. 66061

CPO 03-56 PM US (52888-82170)

RECEIVED
CENTRAL FAX CENTER

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

AUG 06 2008

In re Application of: FREITAG et al.)
Serial No.: 10/598,505) Group Art Unit: TBA
Filed: March 4, 2005) Examiner: TBA
) Conf. No. 6383

For: Recording Medium Storage Package Having Improved Rosette

Mail Stop PCT
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

STATEMENT OF FACTS IN SUPPORT OF FILING ON BEHALF OF
NONSIGNING INVENTORS PURSUANT TO 37 C.F.R. § 1.47(a)

Dear Sir:

I, Ivette Reyes, do hereby declare as follows:

1. I am a Legal Assistant for MeadWestvaco Corporation, assignee of the subject application. I have been directly involved with the preparation and transmittal of correspondence discussed hereinbelow, related to the subject application.
2. This Statement of Facts is made in support of Applicants' Petition Under 37 C.F.R. § 1.47(a), and to set forth the facts relied upon to establish: (i) the refusal of inventor James Philippe to execute an oath or declaration in connection with the above-referenced application, and (ii) the diligent efforts made to secure the execution of a declaration or oath by the non-signing inventor.
3. Unless otherwise noted, this Statement of Facts is based on first-hand knowledge of the undersigned.

STM 254607.1

Serial No.10/598,505
CPG 03-56 PM US (32888-82170)

PATENT

4. James Philippe is one of three named inventors in the above-referenced application, which claims priority to U.S. Provisional Application No. 60/550,654 filed March 5, 2004 and PCT application Number PCT/US05/06871, filed March 4, 2005. Since the time of invention Mr. Philippe has ceased to be employed by MeadWestvaco Corporation, the Assignee of this application (See EXHIBIT 1- executed assignments of two remaining inventors).

5. On January 12, 2007, I personally prepared and sent via Certified Mail No. 7003 2260 0002 7830 5012 a Declaration form, a Power of Attorney form, and an Assignment to Mr. Philippe for review and execution (See EXHIBIT 2). In the mailing, it was requested that Mr. Philippe execute and return the papers, including the Declaration, to Assignee. It is unclear whether Mr. Philippe received this mailing, as a return receipt was never received.

6. On April 12, I again personally prepared and sent, via Express Mail No. ED 579339220 US, a Declaration, a Power of Attorney form, and an Assignment, as well as the application as filed, to Mr. Philippe for review and execution (See EXHIBIT 3). In the mailing, it was requested that Mr. Philippe execute and return the papers, including the Declaration, to Assignee. In this instance, Mr. Philippe received the package as evidenced by a USPS tracking feature and by his response to Assignee by e-mail on April 25, 2007 (See EXHIBIT 4, discussed below).

7. On April 25, 2007, Mr. Philippe responded by e-mail to me regarding the above-mentioned April 12, 2007 letter. In his e-mail, Mr. Philippe indicated that he would not sign the documents provided to him without discussing further financial compensation (See EXHIBIT 4).

Serial No.10/598,503
CPG 03-56 PM US (52888-82170)

PATENT

8. On April 30, 2007, Alexandra Urban, attorney for MeadWestvaco Corporation, sent a letter to Mr. Philippe by e-mail, which I personally mailed by certified mail with return receipt request. In this letter, Ms. Urban again urged Mr. Philippe to sign the relevant documents, and requested a response by May 10, 2007. The letter was signed for by Leslie Philippe, as evidenced by the signed return receipt appended to the exhibit (See EXHIBIT 5).

9. To date, Mr. Philippe has not responded to the April 30, 2007 letter.

10. Pursuant to Rule 1.47(a), the last known addresses of Mr. Philippe was:

James Philippe
7 Deborah Ave.
Sanford, ME 04073

Serial No.10/598,505
CPG 03-56 PM US (52888-82170)

PATENT

11. The undersigned further declares that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under § 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing therefrom.

Respectfully submitted,



Ivette Reyes
Legal Assistant

MeadWestvaco Corporation
299 Park Avenue
New York, NY 10171
UNITED STATES

Customer No. 66061

Date: August 6, 2008

U.S. Patent Application Ser. No. 10/598,505
Inventor(s): FREITAG et al.
Atty. Docket: CPG 03-56 PM US (52888-82170)

EXHIBITS IN SUPPORT OF STATEMENT OF FACTS

STM 254613.1

PAGE 22/35 * RCVD AT 8/6/2008 5:05:57 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/13 * DNIS:2738300 * CSID: * DURATION (mm:ss):04:26

EXHIBIT 1

Attorney Docket: CPG 03-56 PM US

Joint

ASSIGNMENT OF UNITED STATES PATENT APPLICATIONSerial No. 10/598,505
60/550,654Filed: 01 September 2006
05 March 2004

WHEREAS, WE, KENNY FREITAG, a citizen of the United States, residing at 952 Stafford Hill Road, Cheshire, MA 01225, US, JAMES PHILIPPE, a citizen of the United States, residing at 7 Deborah Avenue, Sanford, ME 04073, US, and DANIEL EDWARD CORNWELL, a citizen of the United States, residing at 33 Scalise Drive, Pittsfield, MA 01201, US, invented a certain new and useful RECORDING MEDIUM STORAGE PACKAGE HAVING IMPROVED ROSETTE, for which we executed an application for letters patent of the United States, on even date herewith;

AND WHEREAS, MEADWESTVACO CORPORATION, a corporation duly organized and existing under the laws of the State of Delaware, with principal place of business at 11013 West Broad Street, Glen Allen, VA 23060, US, is desirous of acquiring the entire right, title and interest in and to the said application and the inventions therein disclosed and in any letters patent that may issue thereon;

NOW, THEREFORE, be it known that in consideration of the sum of One dollar (\$1) and other valuable consideration, receipt whereof is hereby acknowledged, WE, KENNY FREITAG, JAMES PHILIPPE and DANIEL EDWARD CORNWELL, hereby sell, assign and transfer unto said MEADWESTVACO CORPORATION, its successors and assigns, the entire right, title and interest in and to said above named application and any divisions or continuations thereof, and the inventions therein disclosed, and to any improvements thereon, and any patent or patents that may be issued or reissued thereon, and we hereby authorize and request the Commissioner of Patents to issue any letters patent thereon, or reissues thereof, to said MEADWESTVACO CORPORATION, its successors and assigns; and we hereby authorize said MEADWESTVACO CORPORATION to file applications for patent, in foreign countries, in connection with the inventions hereby transferred, in its own name and to secure in its own name, the patent or patents issued on such applications; and we hereby agree that, upon request of said MEADWESTVACO CORPORATION, we will sign all papers, and make all rightful oaths, and do all acts, which said MEADWESTVACO CORPORATION may consider necessary in connection with said United States application, and in connection with any other United States or foreign applications that may be filed in connection with this invention and any improvements thereon, or in connection with any patents issued or reissued thereon.

(Signatures on following pages)

Page 1 of 3

EXHIBIT 1

Attorney Docket: CPG 03-56 PM US

Joint

IN TESTIMONY WHEREOF, we hereunto set our hands and seals this 29th day of January, 2008.

Kenny F. Freitag
KENNY FREITAG

State of MA)
County of Berkshire) ss

On this 29th day of January, 2008, before me a Notary Public in and for the above County and State, personally appeared KENNY FREITAG, personally known to me, and acknowledged the execution of the foregoing assignment as his free act and deed for the purpose herein set forth.

Karin Bandini-Perez
Notary Public

SEAL

EXHIBIT 1

Attorney Docket: CPG 03-56 PM US

Joint

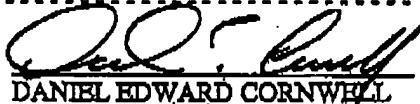
JAMES PHILIPPE

State of)
) ss
County of)

On this _____ day of _____, 2008, before me a Notary Public in and for the above County and State, personally appeared JAMES PHILIPPE, personally known to me, and acknowledged the execution of the foregoing assignment as his free act and deed for the purpose herein set forth.

SEAL

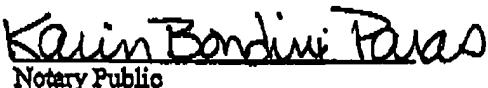
Notary Public


DANIEL EDWARD CORNWELL

State of MA)
)
County of Berkshire } ss

On this 20th day of January, 2008, before me a Notary Public in and for the above County and State, personally appeared DANIEL EDWARD CORNWELL, personally known to me, and acknowledged the execution of the foregoing assignment as his free act and deed for the purpose herein set forth.

SEAL


Karen Bondini Paras
Notary Public

Page 3 of 3

MeadWestvaco Corp
259 Park Avenue
15th Floor
New York, NY 10167

Law Department
T 212.318.5073
F 212.318.5093

EXHIBIT 2

MeadWestvaco

January 12, 2007

Mr. James Philippe
7 Deborah Avenue
Sanford, ME 04073

VIA US CERTIFIED MAIL/RETURN RECEIPT
RE: Signature Forms

Dear Jim,

My name is Ivette Reyes, and I have replaced Dana Copeland (as you may know, has relocated to our Raleigh, NC office) and currently supporting Alexandra Urban as her legal assistant.

Alexandra has asked me to forward the enclosed forms, which require your signature (and notarization of your signature where indicated):

File Reference	Document	Notarization Required ("x")	Witness Required ("x")
CPG 03-36 PM US	Assignment Form	X	
CPG 03-36 PM US	Declaration Form		
CPG 03-36 PM US	Power of Attorney		
CPG 05-11 DB CIF	Assignment Form	X	
CPG 05-11 DB CIF	Declaration Form		
CPG 05-11 DB CIF	Power of Attorney		
CPG 20583	Assignment Form	X	
CPG 20583	Declaration Form		
CPG 20583	Power of Attorney		
CPG 20727	Assignment Form	X	
CPG 20727	Power of Attorney		
CPG 20727	Declaration Form		

Please sign and date each form where indicated by signature line (and have your signature notarized where specified) and return the fully executed originals to me in the New York office before February 1, 2007. A return stamped self-address envelope is enclosed to ease this process.

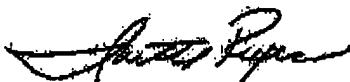
EXHIBIT 2

Mr. James Philippe
12 January 2007
Page 2 of 2

Please don't hesitate to contact me at any time if you have any questions or if I can be of further assistance. I can be reached at (212) 318-5168 or at hr2@meadwestvaco.com or you may contact Alexandra Urban at (212) 318-5675 or ahui1@meadwestvaco.com.

Thank you for your cooperation.

Sincerely,



Ivette Reyes
Legal Assistant

/ir
Enclosures

PLEASE CONFIRM RECEIPT BY EMAIL, FAX, OR TELEPHONE

EXHIBIT 2

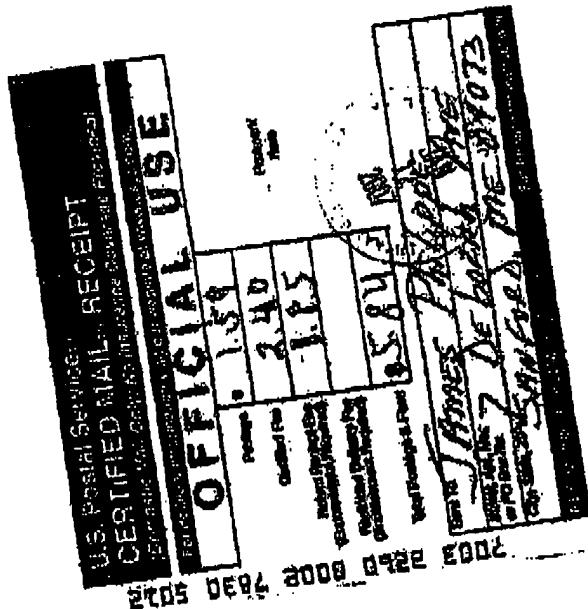


EXHIBIT 3

MeadWestvaco Corporation
550 Park Avenue
16th Floor
New York, NY 10036

Law Department
T 212.318.3675
P 212.318.3616

MeadWestvaco

April 12, 2007

Mr. James Philippe
7 Deborah Avenue
Sanford, ME 04073

VIA USPS Express Mail
Express Mail Label: ED579339220US

RE: Signature Forms
Our Files: CPG 03-56 PM US, CPG 05-11 DB CIP, and CPG 20727

Dear Jim,

Please be advised that we have not received a response from you to the correspondence we mailed to you on January 12, 2007. We are therefore making this second attempt to obtain your signature on the necessary forms (listed below) which require your signature (and notarization of our signature where indicated). Also, enclosed are copies of the related applications as filed.

File Reference	Application Number	Document	Notarization Required? (X)
CPG 03-56 PM US	60/550,654	Assignment Form	X
CPG 03-56 PM US	60/550,654	Power of Attorney and Correspondence Address Indication Form	
CPG 03-56 PM US	60/550,654	Declaration for Utility or Design Patent Application	
CPG 05-11 DB CIP	10/590,981	Assignment Form	X
CPG 05-11 DB CIP	10/590,981	Power of Attorney and Correspondence Address Indication Form	
CPG 05-11 DB CIP	10/590,981	Declaration for Utility or Design Patent Application	

EXHIBIT 3

Mr. James Philippe
April 12, 2007
Page 2 of 2

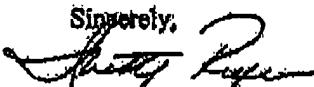
File Reference	Application Number	Document	Notarization Required ("X")
CPG 20727	11/584,288	Assignment Form	X
CPQ 20727	11/584,288	Power of Attorney and Correspondence Address Indication Form	
CPG 20727	11/584,288	Declaration for Utility or Design Patent Application	

Please sign and date each form where indicated by signature flag (and have your signature notarized where specified) and return the fully-executed originals to me in the New York office before April 20, 2007. A return stamped self-address envelope is enclosed to ease this process.

Please don't hesitate to contact me at any time if you have any questions or if I can be of further assistance. I can be reached at (212) 318-5168 or at ir2@meadwestvaco.com or you may contact Alexandra Urban, Senior Intellectual Property Counsel in the New York office, at (212) 318-5675 or aubul@meadwestvaco.com.

Thank you for your cooperation.

Sincerely,


Iyette Reyes
Legal Assistant

Enclosures

USPS - Track & Confirm

EXHIBIT 3



Home of Help

Track & Confirm

Track & Confirm

Search Results

1. *W. E. B. DuBois, 1868-1963* (1963)

Teach & Go With

Enter Label/Receipt Number:

[Additional Details >](#) [Return to USPCE.com Home >](#)

Notification Options

Track & Confirm by email

Get current event information or updates for your item sent to you or others by email. [Go >](#)

Proof of Delivery

Verify who planned for your item by email, fax, or mail. [Go >](#)



POSTAL INSPECTORS
Preserving the Trust

ESTATE PLANNING

contact us. government services jobs. National & Premier Accounts
Copyright © 1999-2004 GRS. All Rights Reserved. Terms of Use Privacy Policy

EXHIBIT 4



"Jim Philippe"
<jimphil2@metrocast.net>
04/25/2007 09:36 PM

To <lr2@meadwestvaco.com>
cc <moldmaker2@metrocast.net>
bcc
Subject: signature request dated Apr 12,07

Ivette Reyes,

I received your signature request package on Apr.14,07.

As I am no longer compensated by employment with MeadWestVaco I will not agree to sign the referenced patent applications without first discussing compensation.

I was the primary inventor on all referenced patents, I will not grant MeadWestVaco ownership of these patents without compensation.

I can be reached by mail, phone 207-490-0820, or by email jimphil2@metrocast.net

James Philippe

This email has been scanned for all viruses by the MessageLabs SkyScan service.

EXHIBIT 5

MeadWestvaco Corporation
299 Park Avenue
19th Floor
New York, NY 10165

Legal Department
T 212 318 5875
F 212 318 5859

MeadWestvaco

April 30, 2007

VIA CERTIFIED MAIL WITH RETURN RECEIPT AND
VIA E-MAIL <simonhill2@metrowest.net>

Mr. James Philippe
7 Deborah Avenue
Sanford, ME 04073

RE: U.S. Patent Application No. 11/584,288, filed October 20, 2006
PACKAGE WITH SECURITY FEATURES
MWV Ref.: CPG 20727 US

U.S. Patent Application No. 10/598,505, filed September 1, 2006
RECORDING MEDIUM STORAGE PACKAGE HAVING IMPROVED ROSETTE
MWV Ref.: CPG 03-56 PM US

U.S. Patent Application No. 11/584,289, filed October 20, 2006
MEDIA CONTAINER WITH BAND HEADER
MWV Ref.: CPG 05-11 DB

Dear Mr. Philippe,

We are in receipt of your e-mail dated April 25, 2007 in connection with the above-referenced applications. As you know, the subject matter embodied in these applications was invented during your employment with MeadWestvaco Corporation. Because your inventive efforts were within the scope of your employment with us, you were compensated by your employment with the company, and the company is the rightful owner of the subject matter contained within the applications and of any patent issuing therefrom.

Accordingly, we would greatly appreciate if you would reconsider your position and sign and return the documents sent to you on April 14, 2007. If we do not receive the executed documents by May 10, 2007, we will have no choice but to notify the U.S. Patent and Trademark Office of your refusal to sign the necessary documents, and we will be forced to proceed without you.

Please contact me if you have any questions.

Sincerely,

Alexandra B. Urban
Alexandra B. Urban, Esq.
Senior Intellectual Property Counsel

EXHIBIT 5**Pollack, Michael**

From: Ivette Reyes [ivette.reyes@meadwestvaco.com] on behalf of Alexandra B Urban
[abu1@meadwestvaco.com]
Sent: Monday, April 30, 2007 8:47 AM
To: Jimphil2@metrocast.net
Subject: Response to your Email dated April 25, 2007
Attachments: Philippe Ltr 30 April 2007.pdf

Alexandra B. Urban
Senior Intellectual Property Counsel
MeadWestvaco Corporation
299 Park Avenue, 13th Floor
New York, NY 10171
Tel: (212) 318-5875
Fax: (212) 318-5035
Cell: (646) 465-0788

This email has been scanned for all viruses by the MessageLabs SkyScan service.

This electronic message contains information from MeadWestvaco Corporation or subsidiary companies, which may be confidential, privileged or otherwise protected from disclosure. The information is intended to be used solely by the recipient(s) named. If you are not an intended recipient, be aware that any review, disclosure, copying, distribution or use of this transmission or its contents is prohibited. If you have received this transmission in error, please notify MeadWestvaco immediately at postmaster@MeadWestvaco.com.

5/11/2007

PAGE 34/35 * RCVD AT 8/6/2008 5:05:57 PM [Eastern Daylight Time] * SVR:USPTO-EXRF-6/13 * DNIS:2738300 * CSID: * DURATION (mm:ss):04:26

UNITED STATES POSTAL SERVICE (PARCELS)

01 MAY 2007 PM

EXHIBIT 5

• **Sender:** Please print your name, address, and ZIP+4 in this box.

Alexander B. Urban, Esq.
Mead Hartman Corp
Law Dept
299 Park Ave - 17th Fl.
New York, NY 10131

117140002 <http://www.lib.utk.edu/utklib/utklib.htm>

U.S. Postal Service
CERTIFIED MAIL RECEIPT
(Domestic Mail Only. No Insurance Coverage Provided)

For delivery information and confirmation of your package

OFFICIAL USE

Postage	• .39
Certified Fee	2.40
Final Certified Fee (Government Required)	1.85
Postage Due Fee (Government Required)	
Total Postage & Fees	6.44

APR 18 1980
8:30 AM

James P. Jones
7 DE 2000
Searfard 1115 24073